



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,578	09/23/2003	Jeffrey A. Kusnitz	RSW920030150US1 (283)	5640

46320 7590 01/29/2009
CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
STEVEN M. GREENBERG
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON, FL 33487

EXAMINER

ADDY, THJUAN KNOWLIN

ART UNIT	PAPER NUMBER
----------	--------------

2614

MAIL DATE	DELIVERY MODE
-----------	---------------

01/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/669,578	Applicant(s) KUSNITZ ET AL.	
	Examiner THJUAN K. ADDY	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on November 03, 2008 has been entered. Claims 9, 10, and 12 have been amended. Claims 1-8 and 17-35 have been cancelled. No claims have been added. Claims 9-16 are now pending in this application, with claim 9 being independent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 9-14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Diacakis (US Patent Application, Pub. No: US 2003/0174814 A1).

3. In regards to claim 9, Diacakis discloses a method, within a telephone (See Fig. 1, wireless telephone 9 or landline telephone 8), for controlling the telephone having a first connection to a packet switched network (See Fig. 1 and IP Network 16) and a second connection to a circuit-switched telephone network (See Fig. 1 and telephone network/PSTN 14), the method comprising storing multiple identifications (e.g.,

Art Unit: 2614

presence/location) for an entity (e.g., individual/recipient) selectable by a user (e.g., subscriber/caller) of the telephone, that can be called from the telephone, storing telephone numbers (e.g., work number, home number, and wireless telephone number) associated with the entity (See pg. 3, paragraph [0036]), receiving, from the packet switched network (via presence server 24, See Fig. 1), presence indicators associated with at least some of the telephone numbers, storing the presence indicators in association with corresponding telephone numbers, and responsive to a selection of an entity by a user, selecting a number for dialing based on the state of the presence indicators associated with the selected entity (See pg. 3, paragraph [0032] and pg. 4, paragraph [0038]).

4. In regards to claim 10, Diacakis discloses the method, further comprising selectively placing calls over the circuit-switched telephone network or over the packet-switched network (See pg. 2, paragraph [0022] – [0023]).

5. In regards to claim 11, Diacakis discloses the method, wherein the telephone comprises a base station (e.g., associated with MSC 18, See Fig. 1) having connections to the circuit-switched network and to the packet-switched network and a mobile device (See Fig.1 and wireless telephone 9) that communicates with the base station using wireless protocols (See Fig. 1 and pg. 2, paragraph [0022]).

6. In regards to claim 12, Diacakis discloses the method, wherein the step of storing telephone numbers further comprises storing at the base station the identification of the entity, the telephone numbers associated with the entity and the presence indicators, and storing at the mobile device the names of the entities, and the method further

Art Unit: 2614

comprises transmitting a name of the selected entity to the base station (See pg. 3, paragraph [0036] and pg. 4, paragraph [0038]).

7. In regards to claim 13, Diacakis discloses the method, further wherein the step of placing calls further comprises routing a call to the circuit-switched network or to the packet-switched network according to a user preference associated with the selected number (See pg. 2, paragraph [0028] and pg. 4, paragraph [0038]).

8. In regards to claim 14, Diacakis discloses the method, further comprising storing user routing preferences based on time-of-day (See pg. 6, paragraph [0056]).

9. In regards to claim 16, Diacakis discloses the method, further comprising the steps of determining if additional numbers are stored for the called entity responsive to an unanswered telephone call and re-trying a call to such an additional telephone number (See pg. 3, paragraph [0032]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Diacakis (US Patent Application, Pub. No: US 2003/0174814 A1).

11. In regards to claim 15, Diacakis discloses all of claim 15 limitations, except the method, further comprising storing user routing preferences based on an area code of

Art Unit: 2614

the selected number. Diacakis, however, does disclose the method, further comprising storing user routing preferences based on time-of-day (See pg. 6, paragraph [0056]).

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate this feature within the system and method, as a way of further defining routing preferences of a user, in relations to a selected/specific number.

Response to Arguments

12. Applicant's arguments with respect to claims 9-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Aravamudan et al. (US 6,301,609) teach assignable associate priorities for user-definable instant message buddy groups. Bogard (US 6,757,365) teaches instant messaging via telephone interfaces. Silver et al. (US Patent Application, Pub. No.: US 2007/0082668 A1) teach a system for automatic selection of profile based on location. Gustavsson et al. (US Patent Application, Pub. No.: US 2004/0092252 A1) teach a method and apparatus for call notification and delivery to a busy mobile station.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2614

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THJUAN K. ADDY whose telephone number is (571)272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thjuan K. Addy/
Primary Examiner, Art Unit 2614